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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/738,317

12/17/2003

Timothy A. Becker

65306-0092

8901

10291 7590 11/06/2008  
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EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

11/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/738,317	<b>Applicant(s)</b> BECKER ET AL.	
	<b>Examiner</b> JAMES W. ROGERS	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6,7,10-17,21,23-32,35 and 37-43 is/are pending in the application.
- 4a) Of the above claim(s) 38-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,7,10-17,21,23-32,35 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicants amendments to the claims filed 10/14/2008 have been entered. Any rejection/objection not addressed in the action below has been withdrawn.

The Declaration under 37 CFR 1.132 filed 10/14/2008 is insufficient to overcome the rejection of claims 1,6,7,10-17,21,23-32,35 and 37 based upon 35 U.S.C. 103(a) as set forth in the last Office action because: while the inventor states in his opinion that the alginates purchased from Pronova within his own dissertation could not be known with certainty, clearly the product catalog is from 2002; in other words it was printed before the current application, which has a filing date of 12/17/2008. Thus it was known before applicants claimed invention that the alginate Pronova UP-LVG had a MW within applicants claimed range. While the examiner does not believe applicant's declaration is false in that Dr. Becker believed the MW was unknown during his work in graduate school the question is whether someone of ordinary skill in the art could construct applicants claimed invention at the time of the claimed invention. Clearly since the commercial product Pronova UP-LVG was known before applicants claimed invention to have a MW within the claimed range the limitation is met. Applicant's opinion on its own merit is insufficient to prove beyond a doubt that the MW of the commercial product Pronova UP-LVG was not known before the filing date of the invention.

### ***Response to Arguments***

Claims 1,6,7,10-17,21,23-24,26,35,37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cochrum (US 5,614,204) in view of Becker (APPLICATION OF

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CALCIUM ALGINATE AS AN ENDOVASCULAR EMBOLIZATION MATERIAL FOR VASCULAR LESIONS, Dissertation, Arizona State University), for the reasons set forth in the previous office action filed 01/17/2008.

Claims 1,6,7,10-17,21,23-32,35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cochrum (US 5,614,204) in view of Becker (APPLICATION OF CALCIUM ALGINATE AS AN ENDOVASCULAR EMBOLIZATION MATERIAL FOR VASCULAR LESIONS, Dissertation, Arizona State University) in view of Ji et al. (US 5,894,022) in view of Reeves (US 5,222,970), for the reasons set forth in the previous office action filed 01/17/2008.

Applicant's arguments filed 10/14/2008 have been fully considered but they are not persuasive. As in the reasoning in the declaration above applicants assert that none of the cited references above teach the use of a purified alginate within the claimed MW range.

For the reasons set forth above the examiner does not find this argument persuasive in that the MW of the commercial product Pronova UP-LVG was known before the filing of applicants claimed invention. Furthermore applicants have not met their burden in showing undoubtedly that the MW of the commercial product was unknown before their claimed invention was filed. The examiner simply cannot remove a rejection based upon an opinion without evidence to the contrary that the MW of the commercial product was unknown.

Applicants further assert that the assumption by the examiner that the alginates of Becker's dissertation would have the same viscosities is misguided since the graph at

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page 27 t does not show viscosity data related to 1% PHG and it cannot be assumed that the alginate would have the same MW and therefore the same viscosity.

The examiner respectfully disagrees, firstly applicants do not claim in claims 35 and 37 1% PHG, thus this assertion is unclear, the examiner can only search for what is claimed, if the composition is the same it will inherently have the same characteristics including viscosity. Since the composition taught by the combination of Kipke and Becker is within the scope of applicants claimed invention it necessarily follows that the properties will be the same. Applicants have not set forth any limitation which distinguishes the ingredients or amounts of those ingredients that would preclude the combination of Kipke and Becker.

### ***Conclusion***

No claims are allowed at this time.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618